HL

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/979,567	11/26/97	SHIOTA K	2091-0145P-S

LM01/1112

BIRCH STEWART KOLASCH & BIRCH
P O BOX 747
FALLS CHURCH VA 22040-0747

EXAMINER	
MORGAN, G	
ART UNIT	**PAPER NUMBER**
2761	4

DATE MAILED: 11/12/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/979,567	Shiota et al
Examiner	**Group Art Unit**
George Morgan	2761

☒ Responsive to communication(s) filed on *Nov 26, 1997* .

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-12* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-12* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Drawings

1. The drawings are not objected to.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

3. The following title is suggested: "Photographic Print Ordering Method".

4. The disclosure is objected to because of the following informalities:

It is unclear what the letters "DPE" stand for (used initially at page 1, line 14). It is suggested that each of the words associated with these letters be spelled out during the first usage. Thereafter, the abbreviation "DPE" may be used.

The first two sentences of the first full paragraph at page 11 (lines 3-6) do not convey meaning: "Furthermore, some users wish a detail specification to be left to the discretion of a service provider. For example, in a trimming service, a customer sometimes requests that an area including this figure is trimmed." These sentences should be re-written in idiomatic English.

Appropriate correction is required.

Claim Objections

5. Claims 8 is objected to because it is either a duplicate of Claim 3, or is so close in content to Claim 3 that they both cover the same thing. See 37 CFR 1.75 and MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3, 8, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 3 and 8 are confusing because the wording "terms of validity of the printing services" is non-idiomatic.

9. Claim 12 is misdescriptive because the preamble calls for a recording medium yet the body merely recites the steps of a program.

Claim 12 is indefinite because it is unclear whether the "recording medium" on lines 9-10 refers to the recording medium mentioned in the preamble.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. For purposes of examining Claims 3 and 8, the language "information regarding the validity of the printing services," will be construed to mean "information regarding the availability of the printing services."

12. Claims 1, 3, 6, 8, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al, U.S. Patent No. 5,799,219, in view of Cameron et al, U.S. Patent No. 5,592,378.

As per Claim 1, Moghadam discloses a picture print ordering system comprising the steps of recording picture image data obtained by reading a developed film (see Figure 4 at ref. no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film) and printing service information regarding the printing service which can be provided for the image data in a predetermined recording medium and displaying the printing service information and the image data recorded in the recording medium when the print ordering information is generated (see Figure 5, which shows printing service information that was recorded for a customer order and then displayed; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes); and generating the print ordering information by using the displayed printing service information (see Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer entering next to the respective image the selection choices). Although Moghadam does not expressly disclose recording and displaying printing service information for all of the printing services that could be performed on the pictures, order entry systems capable of recording information about a product and then

displaying the information to a user are well known. For example, Cameron discloses a computerized order entry system for the placement of an order for an item by a user (col. 2, lines 43-45). The system provides for recording information regarding an item being offered for sale (col. 2, lines 46-48; "A storage mechanism provides for the storing of offer information...") and a data entry system with at least one display (col. 2, 45-46) used to display offer information and to take orders. It would have been obvious to incorporate the complete order entry capabilities of Cameron into the picture print order system of Moghadam. Customers would then be able to conveniently place orders for photographs.

As per Claim 6, Moghadam discloses a picture print ordering system comprising printing service information recording means which records picture image data obtained by reading a developed film (see Figure 4 at ref. no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film) and printing service information regarding the printing services which can be provided to the image data in a predetermined recording medium (see Figure 5, which shows printing service information that was recorded for a customer order and then displayed; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes); and display means which displays the printing service information recorded in the recording medium and the image data when the print ordering information for requesting a printing service regarding the image data recorded in the medium is generated (see Figure 5, which shows printing service information that was recorded for a customer order being displayed); and print ordering information generating means which generates the print

ordering information by using the displayed printing service information received by the input receiving means (see Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer entering next to the respective image the selection choices). Although Moghadam discloses input receiving means which receives input of instruction information using the displayed printing service information (see Figure 4, which shows input means, at 72 via telephone, at 62 via satellite; see Figure 5, which shows a terminal for entering instruction information regarding selection of the individual photographic images along with their respective sizes), he does not expressly disclose a "variety" of the instruction information. Cameron discloses a computerized order entry system for the placement of an ordering instructions for an item by a user (col. 2, lines 43-45). The system provides for recording information regarding an item being offered for sale (col. 2, lines 46-48; "A storage mechanism provides for the storing of offer information...") and a data entry system with at least one display (col. 2, 45-46) used to display offer information and to take orders. It would have been obvious to incorporate the complete order entry capabilities of Cameron into the picture print order system of Moghadam. Customers would then be able to conveniently place orders with a variety of instruction information for photographs.

As per Claims 3 and 8, Moghadam does not expressly disclose that the printing service information includes "information regarding the terms of validity [sic] of the printing services." However, Cameron teaches that a computerized order entry system can provide service information regarding the availability of services being offered (col. 17, line 60 to col. 18, line 8;

explaining that the customer is told if the item is not in stock). It would have been obvious to one skilled in the art at the time the invention was made to incorporate the use of "information regarding the terms of validity [sic]" by Cameron into the printing service information of Moghadam. Customers would be much more willing to place orders if they knew that their orders could be filled.

13. Claims 2, 5, 7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al, U.S. Patent No. 5,799,219 in view of Cameron et al, U.S. Patent No. 5,592,378, as applied to Claims 1 and 6 above, and further in view of PC Magazine Online ("Photo Finishing on the Web").

As per Claims 2 and 7, Moghadam discloses that the printing service information includes the sizes in which a print can be generated (see Figure 5 which displays the available sizes; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes). However, Moghadam does not expressly disclose that the printing service information includes the service charges therefor. Cameron teaches that service information may include the service charges therefor (see Figure 22 and 23, which illustrate service charges for a shirt). Further, PC Magazine Online teaches that customers may order picture prints from picture image data displayed to a customer (page 2, paragraphs 2-4). It would have been obvious to one skilled in the art at the time the invention was made to combine the use of service charges by Cameron and the picture print ordering capabilities of PC Magazine, in order to include picture

service charges in the picture print information of Moghadam. Customers would then be able to to easily place orders knowing the different sizes that are available and the service charges.

As per Claims 5 and 10, Moghadam does not disclose that the printing service information includes information showing the kinds of finishing processing which can be carried out on the picture image when the picture image is printed. However, PC Magazine teaches that the printing service information can include information showing the kinds of finishing processing which can be carried out on the picture image when the picture image is printed (page 2, paragraphs 2-4; explaining that the "PhotoNet" service includes information on reprints, enlargements, touch-up photos, etc. In addition, the article mentions software developed by Microsoft to edit photos could be sent "over the Web to Kodak after choosing from a palette of sizes, resolutions, and other format options.") It would have been obvious to one skilled in the art at the time the invention was made to combine the finishing information taught by PC Magazine with the printing service information of Moghadam.

Customers would find it to be very helpful in making informed purchasing choices to know what finishing options existed.

14. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al, U.S. Patent No. 5,799,219 in view of Cameron et al, U.S. Patent No. 5,592,378, as applied to Claims 1 and 6 above, and further in view of Cloutier et al, U.S. Patent No. 5,229,810.

As per Claims 4 and 9, Moghadam does not disclose that the printing service information includes information showing an apparatus and/or a service provider by which the printing service information has been recorded in the recording medium. However, Cloutier teaches that printing service information may be recorded on a magnetic strip which includes information showing an apparatus and/or a service provider by which the printing service information has been recorded in the recording medium (see Figure 7, which shows "camera identification number," i.e., an apparatus that recorded information on the recording medium, and "Lab ID," i.e., a service provider). It would have been obvious to include this additional information with the printing service information disclosed in Moghadam. Customers would feel much more comfortable placing orders if they knew who would be performing the service on their valuable photographs.

15. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al, U.S. Patent No. 5,799,219 in view of PC Magazine Online ("Photo Finishing on the Web").

As per Claim 11, Moghadam discloses a photo finishing system comprising image data obtaining means which obtains picture image data (see Figure 4 at ref. no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film); print ordering information obtaining means which obtains print ordering information regarding the image data (see Figure 5; col. 6, lines 5-8 explains that an order is accomplished by the customer entering next to the respective image the selection choices; see Figure 4, which shows that ordering information may be obtained by the system via either telephone or satellite

communication); and print generating means which carries out a variety of printing processing based on the print ordering information (see Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer entering next to the respective image the selection choices; the customer chooses which images to print and the sizes); wherein the print ordering information obtaining means obtains print ordering information having been generated by using printing service information and the image data displayed on a predetermined order screen as print services which can be provided for the image data (see Figure 5). Although Moghadam discloses that the print generating means carries out printing processing for providing the printing service displayed as the printing service information, based on the print ordering information (see Figure 5), he does not expressly disclose a "variety of printing processing." PC Magazine teaches that the print generation means may carry out a variety of printing processing (see page 2, paragraphs 2-4; explaining that the "PhotoNet" service includes generating reprints, enlargements, touch-up photos, etc. In addition, the article mentions software developed by Microsoft to edit photos could be sent "over the Web to Kodak after choosing from a palette of sizes, resolutions, and other format options.") It would have been obvious to one skilled in the art at the time the invention was made to combine the print processing taught by PC Magazine with the print processing means of Moghadam. Photographs could then be printed in a manner in which the customer found personally attractive.

16. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al, U.S. Patent No. 5,799,219, in view of Cloutier et al, U.S. Patent No. 5,229,810.

As per Claim 12, Moghadam discloses a program comprising the steps of displaying printing service information and image data of a picture image recorded in a predetermined recording medium on a display apparatus connected to a computer (see Figure 4 at ref. no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film; see Figure 5, which shows picture images and print service information displayed on a terminal); enabling instruction information using the displayed printing service information to be input by input devices of the computer (col. 6, lines 5-8 explains that an order is accomplished by the customer inputting next to the respective image the selection choices; col. 5 lines 66-7 to col. 6 line 1 notes that the screen shown in Figure 5 could be either a home computer or the screen of a TV); and generating the print ordering information based on the instruction information input by the input devices (col. 6, lines 5-8). Although Moghadam discloses more than one type of input device, i.e., home computer and TV, he does not expressly disclose a "variety of input devices." Cloutier teaches that printing service information may be recorded on an magnetic strip which can be read by an input device connected to a computer (col. 3 lines 39-55 summarizing his invention; Figure 2 shows that the read/write process is attached to a microprocessor). It would have been obvious to combine Cloutier's input device, along with other well known input devices, e.g., mouse, light pen, with Moghadam's input devices. The result would be a print ordering system that is more user friendly.

References Cited

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure:

Brown et al (4,972,318) disclose an order entry and inventory control method capable of providing remote order entry for many different types of products, along with inventory control and order validation.

Jaskowsky (4,065,661) discloses a photofinishing apparatus for producing photographic prints and for printing a customer bill controlled by a computer.

Cloutier et al (5,130,745) disclose a transparent magnetic layer in a photographic film used for information exchanging among various user of the film, such as the film manufacturer, the camera user, the dealer, and the photofinisher.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Morgan whose telephone number is (703) 306-2906. The examiner can normally be reached on Monday to Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Voeltz, can be reached on (703) 305-9714. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-5358.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

November 5, 1998 gm

ROBERT A. WEINHARDT
PRIMARY EXAMINER